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SEP 11 2006

Docket No. F-7890

Ser. No. 10/621,765

REMARKS

Claims 1 and 8-12 are pending and claims 4-7 are withdrawn.

Claim 1 has been rejected under 35 USC § 112, second paragraph. In the rejection, the Examiner states that the reference to "depressions" in line 11 is confusing based on the reference to "depressions" in line 9.

Line 9 of Claim 1 recites:

"a support area for supporting said guide plates, said support area being essentially flat without continuous, deep depressions beneath said guide plates".

The depressions referred to in this claim section are illustrated in Figure 1, element 4, and disclosed on page 4 as traversing the railroad tie transversely. The claim recitation clearly recites that such continuous, deep depressions are *excluded from* the claimed structure. In comparison, line 11 of Claim 1 recites:

"said support area includes outer edges, each of said outer edges comprising depressions spaced apart in said crosswise direction for preventing twisting".

The depressions referred to in this claim section are illustrated in Figures 18 and 19, element 21, and disclosed on page 6, penult paragraph as being short, relatively low depressions. The claim recitation clearly recites that such spaced depressions are *included in* the claimed structure.

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Accordingly, when reading the claim in view of the specification, one of ordinary skill would be able to determine that the claimed spaced apart depressions are not the *excluded* continuous, deep depressions beneath the guide plates but are rather the *included* spaced depressions because such an interpretation renders the claim definite and is thus the required interpretation.

The Examiner further contends that it is unclear which depressions are being referenced in line 14 of Claim 1. Applicant respectfully asserts that the reference is to the *included* spaced depressions recited in line 11 and not the *excluded* continuous, deep depressions referenced in line 9. Applicant respectfully asserts that one of ordinary skill would understand that the reference is to *included* depressions because such an interpretation renders the claim definite and is thus the required interpretation.

Based on the above analysis, Applicant respectfully asserts that the rejection of Claim 1 under § 112, second paragraph is not proper.

Claim 8 has been rejected under 35 USC § 112, second paragraph, but the Examiner has not elaborated on the rejection. Applicant respectfully requests that the Examiner elaborate on the rejection or remove the rejection.

Claims 1 and 8-12 are rejected under 35 USC § 103(a) as being unpatentable over the prior art illustrated in Figures 1 and 2. The Examiner relies on MPEP 2144.04 V for the position that separating the claimed depressions is an

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obvious modification over the prior art. Applicant respectfully disagrees and provides the following traverse.

The prior art illustrates depressions which are deep and continuous while the claimed depressions are spaced. Spaced apart depressions lessen the reduction of the concrete cross-section to a necessary minimum value to thereby provide a greater amount of concrete and thereby a greater concrete support structure. In contrast with spaced depressions of the claimed invention, the cross-section of the conventional railroad tie which is the continuous depression is weakened throughout the longitudinal direction because there is less concrete to provide support. The claimed invention prevents twisting and at the same time minimizes the weakening of the cross-section. Based on the differences between the claimed invention and the prior art, the spaced apart depressions provide a tangible structural benefit not realized in the art so that the claimed structure is patentable thereover.

Regarding the Examiner's assertion reliance on MPEP 2144.04 V, Applicant respectfully asserts that such reliance is not proper. In that section of the MPEP, subsection C is being relied upon by the Examiner and the subsection is based on *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). In *Dulberg*, the inventor attempted to patent a separable lipstick cover and the prior art disclosed a lipstick over which was not separable from the lipstick body. Under

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such circumstances, the court determined that the Dulberg invention was not patentable because making the cover removable would be an obvious modification to provide access to the end of the lipstick holder.

Applicant respectfully asserts that the factual circumstance before *Dulberg* is inapposite with the claimed invention. Here, there is no attempt to make an item separable for access to any other part of the item. Rather, *spaced apart* depressions are being provided where the prior art teaches a *single continuous* depression. As indicated, the claimed structure provides a tangible benefit over the known structure in that the resulting structure is more rigid than the known structure in that the claimed spaced apart depressions provide more concrete (between the spaced depressions) to function as the support structure as compared to the prior art continuous depression which provides less concrete to function as the support structure. As a result, the claimed structure is not a mere "making separable" of a known unified structure but a structure which is patentably distinguished over the known structure. Accordingly, neither *Dulberg* nor *MPEP 2144.04 V* are binding in this case.

Based on the structural advantages realized by spaced apart depressions, Applicant respectfully asserts that the spaced apart depressions are not rendered unpatentable by continuous, deep depressions as illustrated in the prior art. As

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such, Applicant respectfully asserts that the rejection of the claims over the illustrated prior art is not proper.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,

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